

AMENDMENTS TO THE DRAWINGS

Replacement sheets for Figures 1-6 are attached.

REMARKS

Claims 1-8 and 18-29 are currently pending in the subject application and are presently under consideration. Claims 9-21 have been cancelled in view of a restriction requirement. Claims 5-8 and 20-21 have been amended to correct informalities. Claims 22-29 have been added to further describe the invention. New claim 22 corresponds with original claims 1 and 15.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claim 1 Under 35 U.S.C. §103(a)

Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over Steffan et al. (US 6,238,940 and Lee (US 6,052,183). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As acknowledged by the Examiner in the Office Action, Lee does not teach or suggest each and every element of the claimed invention as described in the subject claims 1, 2, 3, 4, 8, 18 and 19. Rather, Lee is merely relied upon to cure deficiencies of Steffan et al. The Examiner cites Steffan et al. for its apparent teaching of a "conventional method of monitoring defects at the surface of the wafer." (Paper no. 0903, p. 2, ¶2). However, Steffan et al. is not citable prior art

with respect to the present application. The following is a quotation of 35 U.S.C. §103(c) which forms at least one basis for withdrawal of all rejections in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), and or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject matter of Steffan *et al.* and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to Advanced Micro Devices. Therefore, Steffan *et al.* is not a citable reference with respect to the subject application; and furthermore Lee fails to teach or suggest each and every element claimed in the present invention.

In view of the foregoing, the rejection should be withdrawn.

II. Rejection of Claims 7 and 21 Under 35 U.S.C. §103(a)

Claims 7 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steffan *et al.* and Lee as applied apparently to claims 5 and 18 above, and further in view of admitted prior art. Applicants respectfully note that no rejection has been cited against claim 5. For at least the following reasons, the rejection should be respectfully withdrawn.

As acknowledged by the Examiner in the Office Action, Lee in view of the admitted prior art does not teach or suggest each and every element of the claimed invention as described in the subject claims 7 and 21. Rather, Lee and the admitted prior art are merely relied upon to cure deficiencies of Steffan *et al.* As previously mentioned, the Examiner cites Steffan *et al.* for its apparent teaching of a "conventional method of monitoring defects at the surface of the wafer." (Paper no. 0903, p. 2, ¶2). However, once again, Steffan *et al.* is not citable prior art with respect to the present application. The following is a quotation of 35 U.S.C. §103(c) which forms at least one basis for withdrawal of all rejections in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), and or (g) of section 102 of

this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject matter of Steffan *et al.* and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to Advanced Micro Devices. Therefore, Steffan *et al.* is not a citable reference with respect to the subject application; and furthermore Lee and the admitted prior art fails to teach or suggest each and every element claimed in the present invention.

In view of the foregoing, the rejection should be withdrawn.

III. Rejection of Claims 6 and 20 Under 35 U.S.C. §103(a)

Claims 6 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steffan *et al.*, Lee as applied to claims 5 and 18 above, and further in view of Sugimoto *et al.* (US 6,320,401) and admitted prior art. Applicants respectfully note that no rejection has been cited against claim 5. For at least the following reasons, the rejection should be respectfully withdrawn.

As acknowledged by the Examiner in the Office Action, Lee, Sugimoto *et al.* and the admitted art, either individually or combined, do not teach or suggest each and every element of the claimed invention as described in rejected claims 6 and 20. Rather, Lee, Sugimoto and the admitted prior art are merely relied upon to cure deficiencies of Steffan *et al.* As discussed above with respect to claims 1, 2-4, 7-8, 18, 19, and 21, the Examiner cites Steffan *et al.* for its apparent teaching of a "conventional method of monitoring defects at the surface of the wafer." (Paper no. 0903, p. 2, ¶2). However, Steffan *et al.* is not citable prior art with respect to the present application. The following is a quotation of 35 U.S.C. §103(c) which forms at least one basis for withdrawal of all rejections in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), and or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject matter of Steffan *et al.* and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to Advanced Micro Devices. Therefore, Steffan *et al.* is not a citable reference with respect to the subject application; and furthermore Lee, Sugimoto *et al.* and the admitted prior art fail to teach or suggest each and every element claimed in the present invention.

In view of the foregoing, the rejection should be withdrawn.

IV. Election/Restrictions Under 35 U.S.C. §121

The present invention was subjected to a restriction requirement as follows:

- I. Claims 1-8, 18-21, drawn to a method, classified in class 438, subclass 689.
- II. Claims 9-17, drawn to an apparatus, classified in class 250, subclass 306.

Applicants hereby affirm the election of claims 1-8 and 18-21 which are drawn to a method. New claims 22-29 read on the elected Group I.

V. Objections to Claims 5-8 and 20-21

Claims 5-8 and 20-21 have been objected to for informalities. In particular, the term "system" in the preamble should be replaced with "method." The claims have been amended accordingly. Thus, the objection should be withdrawn.

VI. Conclusion

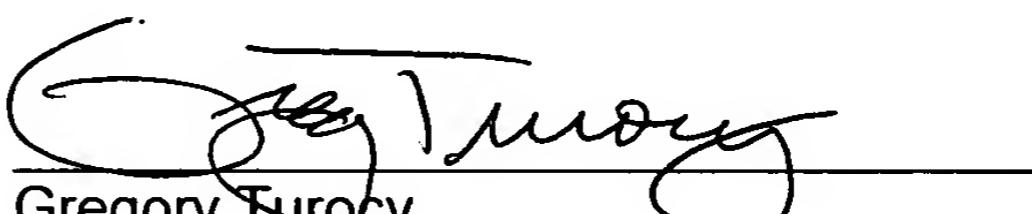
The present application is believed to be condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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